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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.          | CONFIRMATION NO.   |
|--|-------------|----------------------|------------------------------|--------------------|
| 09/954,555   | 09/17/2001  | Paul J. Thompson     | 11576.55US11                 | 9046               |
| 23552  | 7590        | 11/28/2003           |                              |                    |
| MERCHANT & GOULD PC<br>P.O. BOX 2903<br>MINNEAPOLIS, MN 55402-0903 |             |                      | EXAMINER<br>STEWART, ALVIN J |                    |
|  |             |                      | ART UNIT<br>3738             | PAPER NUMBER<br>11 |
| DATE MAILED: 11/28/2003  |             |                      |                              |                    |

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/954,555

Applicant(s)

THOMPSON ET AL.

Examiner

Alvin J Stewart

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-34,36-39 and 44-52 is/are pending in the application.
- 4a) Of the above claim(s) 7-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-34, 36-39, 45-51 is/are rejected.
- 7) ☒ Claim(s) 44 and 52 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2-6
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### *Election/Restrictions*

Applicant's election of Species X in Paper No. 9 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 3, 35 and 40-43 are canceled.

Claims 7-11 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 9.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2, 4-34, and 45-49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "interlock structures positioned within 5 millimeters of the cell defining region of the implant" is not understood (see also claims 16, 17, 24, 25, 37 and 39). The Examiner's interpretation regarding the above phrase is that the male interlock structure extends 5 millimeters inside the cell regions. If this is correct, it is totally different that the teaching in the specification and claims.

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Does the Applicant is trying to claim the distance between the free terminal ends of the struts 286a to the free ends of the interlock structure 282? Or the Applicant is trying to claim the thickness of element 282 as shown in Fig. 6C?

The Applicant should clarify that the interlock structures are positioned completely within 5 millimeters of the first end of the implant.

Claim 45 recites the limitation "cell defining regions" in line 6. There is insufficient antecedent basis for this limitation in the claim. In line 5, the applicant has to add an "s" in the word "region". Correction is required.

***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 5, 6, 16-17, 21-25, 36-39, 45-47, and 50-51 are rejected under 35 U.S.C. 102(e) as being anticipated by Letendre et al US Patent 6,267,783 B1.

Letendre et al discloses a catheter (40) having an elongated member (60), a stent (12), a sheath (50), a male interlock (20), a female interlock (54), and a cell defined region (see Figs. 3-5). The sheath is slidably positioned between an opened configuration and a closed configuration. The interlock configurations are capable of having any shape (see col. 8, lines 19-20).

\*Note: Regarding the phrase "interlock structures positioned within 5 millimeters of the cell defining region of the implant" the Examiner has interpreted the above phrase as follow: the interlock structures are located within 5 millimeters of the cell region or within 5 millimeters of the first end of the implant. Therefore, any male interlock structure longer than 5 millimeters is

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within 5 millimeters of the cell region or within 5 millimeters of the end of the implant (see attachment). The applicant is not specifically saying that the male interlock structure extends 5 millimeters from the end of the cell-defining region to the end of the stent.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 4 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Letendre et al US Patent 6,267,783 B1 in view of Johnson et al US Patent 5,817,102.

Letendre et al discloses the invention substantially as claimed. However, Letendre et al does not disclose an elongated member comprising radiopaque markers positioned adjacent to the implant.

Johnson et al teaches a catheter comprising a tubular member (26) covered by a stent (66) and covered by a sheath (18). The elongated member comprises a plurality of radiopaque markers (58, 60, 62 and 64) for the purpose of locating the catheter and the stent during the deployment of the stent (see col. 6, lines 1-3).

\*Note: It is well known in the art to use radiopaque markers in order to locate the catheter within the body).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to add the radiopaque markers of the Johnson et al catheter to the elongated

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member of the Letendre et al reference in order to locate the catheter and the stent within the body.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 50 and 51 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 32, 41 and 42 of U.S. Patent No. 6,623,518 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because both cases disclose a catheter, an elongated body, a stent mounting location, an expandable stent, the stent including first and second ends, the stent including first interlock structures and the elongated body including second interlock structures.

Regarding claim 1, the interlock structure is within 5 millimeters of the first end of the implant.

### ***Allowable Subject Matter***

Claims 44, and 52 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Claims 29-34 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

Claims 18-20, 26-28, 34, 48 and 49 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin J Stewart whose telephone number is 703-305-0277. The examiner can normally be reached on Monday-Friday 7:00AM-5:30PM(1 Friday B-week off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 703-308-2111. The fax phone number for the organization where this application or proceeding is assigned is 703-305-3590.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

A handwritten signature in black ink, appearing to read 'Alvin Stewart', with a stylized flourish at the end.

Alvin Stewart  
November 24, 2003.

**FIG. 1**

